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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,956	10/05/2004	Hisao Nakaoka	040434	5061

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EXAMINER	
CUTLIFF, YATE KAI RENE	

ART UNIT	PAPER NUMBER
1621	

MAIL DATE	DELIVERY MODE
06/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/508,956	NAKAOKA ET AL.	
	Examiner	Art Unit	
	YATE K. CUTLIFF	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7,9,16-23,30,31 and 33-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *30,31 and 33-37* is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 7, 9 and 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Koehler et al. (US 5,917,097).

3. The rejected claims cover, inter alia, a liquid vegetable unsaturated alcohol mixture that has a iodine value of 88 to 100, a cloud point of less than 7°C and a conjugated diene compound content of 1wt% or **less**.

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003). The term "less" as applied to the conjugated diene content is been interpreted to denote ".99 to 0 wt%".

Koehler et al. discloses oleyl alcohol from palm kernel oil with an iodine value of 94, a solidification point of 7°C and containing C16 and C18. (see column 3, lines 58-62). The vegetable alcohol of Koehler is produced by the reduction of a vegetable fatty acid or methyl ester using a Cu/Cr/Zn mixed oxide catalyst. (see column 4, lines 46-64). Derivations of the include alkoxylates by the addition of ethylene oxide, ether sulfates, fatty alcohol sulfates and esters of the unsaturated fatty alcohol. (see column 5, lines 35-67 & column 6, lines 1-14). The unsaturated fatty alcohol of Koehler et al. can be used in cremes, emollients and lotions. Koehler et al., in Table 3, is silent with regards to conjugated diene content of the unsaturated fatty alcohol produced from palm kernel oil and coconut oil, as such it can be presumed that the unsaturated fatty alcohol of Koehler et al. does not contain any conjugated diene.

Applicants claimed liquid vegetable unsaturated alcohol mixture can have zero conjugated diene compounds; the composition of Koehler et al. has no conjugated diene. Further, the composition of Koehler et al. and the claimed composition were prepared using similar starting materials and method steps and contain similar iodine values and cloud points, it is reasonable to conclude that the product of Koehler's process is the same as that of the process recited by Applicant.

Applicant is reminded that claims 1-4, 6, 7, 9 and 16-23 are claimed in a Product-by-Process format. It is "well settled that the presence of process limitations in product claims, which product does not otherwise patentably distinguish over the prior art, cannot impart patentability to that product." *SmithKline Beecham Corp. v. Apotex Corp.,*

439 F.3d 1312, 1318 (Fed. Cir. 2006) (quoting *In re Stephens,* 345 F.2d 1020, 1023 (CCPA 1965).

The PTO takes the following position with respect to Product- by-Process claims, As stated *in In re Thorpe,* 777 F.2d 695, 697, 698,227 USPQ 964, 966 (Fed. Cir. 1985): Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

In Examination, "the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., In re Garnero, 412 F.2d 276, 279, 162 USPQ 221,223 (CCPA 1979). "The Patent Office bears a lesser burden of proof in making out a case of *prima* facia obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

Additionally, once the Examiner establishes that a product, recited in terms of its process of making, is prima facie unpatentable due to anticipation, Applicant bears the burden of proving "that the prior art products do not necessarily or inherently possess

the characteristics of his claimed product." *Id.* at 698 (quoting *In re Fitzgerald,* 619 F.2d 67, 70 (CCPA 1980); *In re Best,* 562 F.2d 1252, 1255 (CCPA 1977)).

Response to Amendment

4. The amendment to claims 1, 3, 4 7, 9, 16 and 30 of February 29, 2008 are acknowledge and entered.

Response to Arguments

5. Applicant's arguments with respect to claims 1-4, 6, 7, 9 and 16-23 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

6. Claims 30, 31 and 33-34 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: The claimed process is unobvious over the prior art of record because the prior art of record does not teach or suggest the process of the claimed invention, whereby the vegetable unsaturated alcohol produced by reduction of the fatty acid mixture and/or an alkyl ester, is slightly hydrogenated.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YATE K. CUTLIFF whose telephone number is (571)272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272 - 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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